

REMARKS

Claims 10, 11, 13-15, and 21-31 are pending. In this paper, claims 10 and 25 have been amended to correct a typographical error (“power” was corrected to “powder”) and claim 23 was amended to recite a glass layer instead of “glass-type filter.” Applicants submit that these amendments are sufficient to overcome the § 112, second paragraph. Claims 13 and 27 have been amended to recite types of optical filter films. The remaining remarks address the § 103 rejection.

I. Claims 10 and 25 Are Allowable Over the Kawamura Patent

In the Final Office Action, the Examiner maintained the rejection of claims 10, 11, 13-15, and 21-31 based on the Kawamura patent. Applicants submit that the reasons for maintaining this rejection are improper as a matter of law, and consequently a *prima facie* case of obviousness as defined by the requirements of MPEP §§ 2142 and 2143 has not been established.

A. First Claimed Feature

Claim 10 recites an adhesive layer for adhering at least two optical films to each other, with a “conductive powder decentralized within the adhesive layer to within a predetermined concentration range by volume ratio relative to an amount of adhesive agent in the adhesive layer, said predetermined concentration range set to allow the plasma display panel to achieve a desired transmission rate.” The Examiner declined to give patentable weight to

these features on grounds that they are written in narrative in form and therefore do not constitute or contribute toward positive structure of the claimed device. This rationale is improper.

The MPEP defines what constitutes “narrative form” in MPEP §§ 706.03(k) and (d). Under these MPEP sections, a claim is considered to be in narrative form if it is replete with grammatical and idiomatic errors, or if it is replete with indefinite and functional or operational language. Neither is the case with respect to claim 10.

The language used to define the conductive powder in claim 10 is not replete with grammatical and idiomatic errors, nor is it replete with indefinite and functional or operational language. Rather, claim 10 uses definite and affirmative language to define the composition of the conductive powder as incorporated within the front filter.

Specifically, the conductive powder is decentralized within the adhesive layer not in a random manner, but “to within a predetermined concentration range by volume ratio relative to an amount of adhesive agent in the adhesive layer.” Claim 10 further recites that the predetermined concentration range does not achieve random effects, but is “set to allow the plasma display panel to achieve a desired transmission rate.” The language in claim 10, therefore, is not written in narrative form but rather provides a positive and definite recitation of the structure (namely, the composition and the effects to be achieved in terms of transmission rate) of the conductive powder.

Moreover, objecting to the manner or form of a claim does not constitute a valid ground on which to issue a rejection under 35 USC § 103(a). A rejection based on claim form is properly made under § 112, second paragraph. However, because the structure of the conductive powder is clearly and positively recited in claim 10, a § 112, second paragraph, rejection of claim 10 would be improper.

For the foregoing reasons and under MPEP §§ 706.03(d) and (k), all the features in claim 10 are required to be given patentable weight in considering the question of patentability under § 103(a).

Turning now to the substance of the § 103(a) rejection, to establish a *prima facie* case of obviousness of claim 10, the Examiner must show that the Kawamura patent teaches or suggest all the features recited in this claim. (See MPEP §§ 2142 and 2143). The Kawamura patent does not teach or suggest the structure of the composite powder recited in claim 10 or its effect of producing a desired light transmission rate.

As shown in Figure 3a, the Kawamura antistatic layer 2 is formed between anti-reflective layer 6 and the CRT screen. Kawamura discloses that layer 2 is formed from a metal, e.g., SnO₂, In₂O₃, or Sb₂O₃. Kawamura does not disclose that this metal is decentralized, or otherwise mixed with, an adhesive agent to within a predetermined concentration range by volume ratio in the adhesive layer as recited in claim 10. Rather, Kawamura discloses that metal layer 2 is merely applied and heated over the CRT screen. (See column 7, line 66 - column 8, line

8). Kawamura further fails to teach or suggest that the predetermined concentration range is intentionally “set to allow the plasma display panel to achieve a desired transmission rate.”

Absent a teaching or suggestion of these features, it is respectfully submitted that the Kawamura patent cannot properly be relied on to establish a *prima facie* case of obviousness of claim 10 or any of its dependent claims.

B. Second Claimed Feature

Claim 10 recites “at least two optical filter films coupled over a surface of a plasma display panel” and that “an adhesive layer for adhering the at least two optical filter films to each other, the adhesive layer including a conductive powder to shield electromagnetic waves.” On page 4 of the Final Office Action, the Examiner stated that Kawamura uses “one optical filter film as opposed to applicant’s claimed two optical filter films and the adhesive layer adhering the two optical filter films to each other.”

By making this statement, the Examiner has expressly admitted on the record that claim 10 recites structure features different from those disclosed in Kawamura, i.e., the claimed invention uses two optical filter films bound together by an adhesive layer containing a conductive power with the specific structural properties and optical transmission effects discussed above. In contrast, Kawamura discloses a single antistatic layer 2 which omits a conductive power as claimed. These structural differences are clear and not taught or suggested

by Kawamura. Accordingly, for this additional reason, the Kawamura patent cannot be relied on to establish a *prima facie* case of obviousness of claim 10 or any of its dependent claims.

In effort to explain away the differences between claim 10 and Kawamura, the Examiner stated that replacing the antistatic layer in Kawamura with the structure in claim 10 would merely have been a design choice. However, both the Board and the Federal Circuit have been very careful to outline when and when it is not proper to rely on design choice in issuing a § 103(a) rejection.

In order to properly assert that features in a claim are a matter of design choice under § 103(a), the Examiner must show: (1) the feature was known at the time the claimed invention was made and (2) there exists some teaching or suggestion in the art that would have lead one of ordinary skill in the art to modify the primary reference (in this case, the Kawamura patent) to include the feature. (See MPEP 2144.04 and In re Chu, 36 USPQ.2d 1089, 1095 (Fed. Cir. 1995). In the present case, the Examiner has failed to make either showing.

Specifically, the structural features recited in claim 10 (namely “at least two optical filter films coupled over a surface of a plasma display panel” and that “an adhesive layer for adhering the at least two optical filter films to each other, the adhesive layer including a conductive powder to shield electromagnetic waves”) were not known at the time the claimed invention was made. This is clear from the record, because if those features were known the Examiner would have cited a reference to prove that they were known. No such reference has

been cited. (On page 4 of the Final Office Action, the Examiner stated that “providing the two optical filter films is also in the art;” however, the Examiner has not cited a reference to show that this is true.)

Also, the Examiner has failed to show that some teaching or suggestion was in existence at the time the claimed invention was made that would have lead one of ordinary skill in the art to modify the Kawanura structure to include the features recited in claim 10. This is also clear from the record, since the neither the Kawamura patent itself nor any other reference of record was relied on to show a motivation to modify Kawamura. Rather, the Examiner merely gratuitously asserted that such a modification would have been an obvious design choice. Such a basis for rejecting claim 10 under § 103(a) is improper for being based on a hindsight analysis. See In re Fine, 5 USPQ.2d 1596 (Fed. Cir. 1988).

For all of the foregoing reasons, Applicants submit that claim 10 and its dependent claims are allowable over the Kawamura patent. Claim 25 recites features similar to those which patentably distinguish claim 10 from Kawamura. Accordingly, it is submitted that claim 25 and its dependent claims are also allowable.

II. The Dependent Claims

Claim 11 recites that the predetermined concentration range of the conductive powder is 1-40% of the adhesive agent by volume ratio. In the Final Office Action, the Examiner admitted that Kawamura does not teach or suggest these features. Nevertheless, the Examiner stated that

such features would have obvious because these features are merely general, optimum or workable conditions that may be determined using routine skill.

Again, this is an improper basis for rejecting a claim under § 103(a). It is incumbent upon the Examiner to show, as a matter of law, that the features of a claim were known at the time the claimed invention was made. Absent a teaching or suggestion of these features, a *prima facie* case of obvious cannot properly be established. The Examiner's gratuitous assertions, without more and specifically without the citation of a reference to prove his position, do not constitute a showing sufficient to establish a *prima facie* case of obviousness. See MPEP §§ 2142 and 2143. Accordingly, it is submitted that claim 11 is allowable.

Claim 13 recites that the at least two optical filter films are an antireflection coating and an infrared-ray shield film. The Kawamura patent does not teach or suggest these features. Rather, Kawamura only discloses an underlying conductive coating and a reflection inhibiting coating on a CRT. See Figs. 3(a) and 3(b).

Moreover, the Kawamura patent does not teach or suggest that the conductive powder recited in claim 10 "is formed of any one of copper (Cu), silver (Ag), gold (Au), aluminum (Al), nickel (Ni), platinum (Pt), and carbon nanotube (CNT)" as recited in claim 14. Rather, Kawamura only discloses Sn-, In-, and Sb-based metals. None of the metals recited in claim 14 are taught or suggested in this patent.

None of the references individually or collectively teach or suggest that the conductive powder of claim 10 “has a particle size of between several nm to 380nm” as recited in claim 15.

Claim 21 recites that the predetermined concentration range of the conductive powder of claim 10 “is set to allow the plasma display panel to transmit visible rays in the range above 380 nm.” (See, for example, Paragraphs [59] and [67] for support.) These features are not taught or suggested by the Kawamura patent.

Claims 25-31 are allowable for reasons similar to those which patentably distinguish claim 10 and its dependent claims from the references of record.

III. Additional Reasons the Rejection is Improper

In rejecting dependent claims 11 and 28, the Examiner additionally stated the Applicant has not shown that the recited concentration range of the conductive powder of being “1-40% of the adhesive agent by volume ratio” produces any unexpected results. (See Pages 7 and 8).

First, the proper test for establishing a *prima facie* case of obviousness is not unexpected results. That is, while a showing of unexpected results may be one way of showing non-obviousness, it is by no means the only way to show non-obviousness. See In re Peterson, 65 USPQ.2d 1379, 1382 (Fed. Cir. 2003) and In re Geisler, 43 USPQ.2d 1462 (Fed. Cir. 1997).

Moreover, the Board and Federal Circuit have made clear that when a range is recited in a claim, the question of whether that range is non-obvious must be determined in relation to the

specific range that is recited in the applied references. (See Peterson and Geisler.) In the present case, only one reference has been applied (namely, the Kawamura patent), but that reference does not teach or suggest a conductive powder at all, let alone a conductive powder contained in an adhesive for binding the recited optical filter films, where that powder has a concentration range of “1-40% of the adhesive agent by volume ratio.”

Without a teaching or suggestion of a conductive powder or of any range associated with that conductive powder in any of the references of record, the question of whether the inventions defined in claims 11 and 28 are obvious does not turn on whether the recited ranges produce unexpected results. Rather, it turns on whether the Kawamura teaches or suggests the structure of the optical filter films and conductive powder recited in base claims 10 and 25, and then whether Kawamura teaches or suggests that such a power has the recited concentration range. Kawamura does not teach or suggest these features. In fact, the Kawamura patent does not even teach or suggest a conductive powder. Therefore, as a matter of law, Kawamura must be determined to be insufficient for purposes of establishing a *prima facie* case of obviousness.

Moreover, regarding the concentration range in claims 11 and 28, Applicants note that “obvious to try” is not the proper standard for determining patentability under § 103(a). (See In re Fine cited above and most recently Takeda Chem. Indus., Ltd. v. Alphapharm Pty. Ltd., Docket No. 06-1329, Federal Circuit 2007). Rather, the specific test set forth in MPEP §§ 2142

and 2143 is the proper test, which for the reasons noted above is not satisfied by the Kawamura patent.

IV. Conclusion

In summary, the Kawamura patent discloses using a single antistatic layer 2 on the surface of a CRT monitor to remove static electricity. The Karamura patent does not teach or suggest a front filter having the specific structure of at least two optical filter films coupled over a surface of a plasma display panel and an adhesive layer for adhering the at least two optical filter films to each other. Kawamura also fails to teach or suggest that the adhesive layer includes a conductive powder to shield electromagnetic waves, said conductive powder decentralized in the adhesive layer to within a predetermined concentration range by volume ratio relative to an amount of adhesive agent in the adhesive layer, said predetermined concentration range set to allow the plasma display panel to achieve a desired transmission rate. Based on these differences, it is respectfully submitted that claims 10 and 25 are allowable.

Kawamura also fails to teach or suggest the features recited in the dependent claims. Applicants therefore submit that these claims are also allowable, not only by virtue of their dependency from claims 10 and 25 but also based on the features separately recited therein.

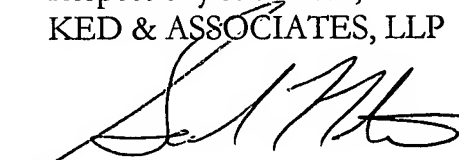
Serial No.10/812,903
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In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance. Favorable consideration and timely allowance of the application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

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